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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,634	10/11/2005	Brian Seed	00786/432002	4930
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CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110				
EXAMINER				
WILSON, MICHAEL C				
ART UNIT		PAPER NUMBER		
1632				
NOTIFICATION DATE		DELIVERY MODE		
04/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentadministrator@clarkelbing.com

Office Action Summary

Application No.

10/521,634

Applicant(s)

SEED ET AL.

Examiner

Michael C. Wilson

Art Unit

1632

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

The following office action is to clarify an inadvertent error in the office action sent 3-26-08. The 102 rejection has been maintained as evidenced by the detailed explanation of how the reference meets the limitations of the claims as amended. Accordingly, this office action remains final because it does not have any new grounds of rejection.

Claims 13-17 and 20-39 have been canceled. Claims 1-12, 18 and 19 remain pending and are under consideration.

Applicant's arguments filed 12-20-07 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 1-12, 18 and 19 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claim 1 regarding the metes and bounds of what applicants consider "substantial sequence identity" has been withdrawn in view of the amendment.

The rejection of regarding the use of "cell(s)" in claim 1 has been withdrawn in view of the amendment.

Claim 2 as amended is indefinite because the structure of the artificial chromosome is not clearly set forth. It cannot comprise one nucleic acid sequence that

is at least 90% identical to two regions of homology. It must comprise one nucleic acid sequence that is each at least 90% identical to the first region of homology and a second nucleic acid sequence that is each at least 90% identical to the second region of homology. The step in claim 2 is also confusing because it occurs prior to those in claim 1 but does not clearly set forth the structure of the cassette (i.e. having a first region, second region, selectable marker, etc). Nor does it clearly set forth introducing the cassette into host cells (yeast) comprising the artificial chromosome. Clarification is required.

Claim 4 as amended remains indefinite because it does not clearly further limit claim 2. The limitation as amended fails to clearly set forth inserting a circular vector comprising the linear DNA into the host cells (yeast) and cleaving the vector to generate the linear DNA. In addition, further limiting the linear DNA as written is a misnomer because the limitation is actually a method step. The limitation in claim 4 should be written as a method step.

Claim 9 remains indefinite because "the activity of the protein encoded by a nucleic acid of interest that includes said first or second region of said endogenous chromosome" lacks antecedent basis.

Claim 10 as amended is indefinite because "the amount of functional protein..." lacks antecedent basis.

The rejections of claims 11 and 12 have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102

Claims 1-12, 18 and 19 remain rejected under 35 U.S.C. 102(a) as being anticipated by Wilson (Analytical Biochem., Sept. 15, 2001, Vol. 296, No. 2, pg 270-278) for reasons of record.

Wilson cultured yeast with linear DNA comprising a cassette encoding a selectable marker operably linked to a promoter (pg 270-271, Cassettes A-G). The cassettes were PCR'd to have overlapping ends homologous to the IL-10R α or PPAR γ genes (pg 271, col. 2, PCR of the targeting gene). Primer pairs used to make the cassette had a first and second region of homology having at least 90% sequence identity to the IL-10R α or PPAR γ genes (pg 272, Table 1). The cassettes made by Wilson are equivalent to the cassette in section (a) of claim 1.

Amplified cassettes were transformed into YAC-containing yeast strains comprising a nucleic acid sequence that was at least 90% identical to said first and second regions of homology such that recombination occurs (pg 271, col. 2, Transformation of yeast strains), which is equivalent to the step in claims 2 and 4.

The homologously recombined locus (made in YAC-containing yeast) was isolated as a 6-15 kb piece of DNA and then cloned into plasmid (pg 272, Isolation of the targeted locus; see also the "Overview of the procedure" on pg 273-275, specifically pg 275, col. 1, line 1). ES cells were transfected with linearized targeting vector. Transfecting ES with a plasmid comprising 6-15 kb fragments isolated from YAC is equivalent to inserting an "artificial chromosome" as into mammalian cells as claimed. "Artificial chromosome" encompasses any chromosome or fragment thereof having an

artificial modification (pg 14, line 17), which is equivalent to the fragments from the yeast artificial chromosome isolated by Wilson, put into plasmid and inserted into ES cells.

Transformation (claim 3) is the same as transfection taught by Wilson.

In the PPAR γ example, contiguous regions of exon 5 are deleted (paragraph bridging pg 276-277; pg 277, Fig. 4), which is equivalent to claims 5 and 6.

In the IL-10R α example, two exons and an intervening intron are deleted (pg 275, col. 2, Examples, line 9), which is equivalent to 7 and 8.

Southern blot analysis showed the genes were deleted, which inherently indicates the amount of functional protein was less than 25% as claimed as in claim 10.

Fig. 2 shows the various selectable marker strategies, which are equivalent to claim 11 and 12.

The ES cell clones were used to make germline-transmitting chimeras (pg 277, last sentence in the caption of Fig. 4), which is equivalent to claim 19 because the germline-transmitting chimeras inherently transmit the deletion to both somatic and germ cells.

Applicants argue Wilson transfected ES cells with plasmid not artificial chromosomes as claimed. Applicants argue claim 1 requires inserting an artificial chromosome directly into mammalian cells. Applicants' arguments are not persuasive. Claim 1 does not require "transfecting" mammalian cells with artificial chromosomes or inserting the artificial chromosome "directly" into the cells. Claim 1 merely requires inserting artificial chromosomes into mammalian cells. Furthermore, the definition on pg

14, "artificial chromosomes" encompasses artificial chromosome fragments. Therefore, the 6-15 kb homologously recombined cassette fragments isolated from YAC described by Wilson (sentence bridging pg 274-275) are "artificial chromosomes" as claimed. The "artificial chromosomes" described by Wilson are "inserted" into mammalian cells as claimed because they are put into ES cells using a plasmid. Claim 1 is not limited to inserting an "artificial chromosome" in the absence of a plasmid. Accordingly, the teachings of Wilson meet the limitation of "inserting" an "artificial chromosome" into a mammalian cell as claimed.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1632

Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached at the office on Monday, Tuesday, Thursday and Friday from 9:30 am to 6:00 pm at 571-272-0738.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Peter Paras, can be reached on 571-272-4517.

The official fax number for this Group is (571) 273-8300.

Michael C. Wilson

/Michael C. Wilson/
Patent Examiner